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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,079	09/11/2000	Brian M. Romansky	E-996	4596

919 7590 04/26/2005

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EXAMINER

ELISCA, PIERRE E

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/658,079	ROMANSKY, BRIAN M.	
	Examiner	Art Unit	
	Pierre E. Elisca	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office action is in response to Applicant's response, filed on 01/10/2005.
2. Claims 1-41 are pending.

Claim Objections

3. Claims 6-10, 20, 29, 35 and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 3, 4, 5, 11-19, 21-28, 30-34 and 36-40 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Krishan et al. (U.S. Pat. 6,442,529) in view of Williams et al (U.S. Pat. No. 4,517,410).

As per claims 1, 3, 4, 5, 12-14, 17, and 24-26 Krishan substantially discloses a method and apparatus for delivering targeted information and advertising over the Internet, comprising:

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embedding a code in said message (see., abstract, figs 2 and 6B, col 9, lines 23-35, col 17, lines 10-67, col 18, lines 1-5);

detecting the embedded code (see., abstract, col 18, lines 1-5); and

based on the detected embedded code (see., abstract, figs 2 and 6B, col 9, lines 23-35, col 17, lines 10-67, col 18, lines 1-5). It is to be noted that Krishan fails to explicitly disclose wherein said counting the number of times the message is presented to a user of the communications network. However, Lee discloses a counter means associated with said monitoring means of said controller for counting the number of times each one of a plurality of said message identifiers is entered by the user indicating the number of times each message is requested to be played back to the user, and means for storing an accumulated count after each message is played back for permitting an operator to read out the accumulated counts (see., abstract, col 13, lines 25-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Krishan by including the limitation detailed above as taught by Williams because this would detect and count message data associate with each user (s).

As per claims 2, 16, and 19 Krishan discloses the claimed method, wherein the communications network includes the internet (see., figs 1A and 1B, col 5, lines 52-67, col 6, lines 167, col 7, lines 1-67).

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As per claims 11, 15, 18, 21, and 23, Krishan discloses the claimed method wherein the digital content is indicative of an advertisement (see., abstract, figs 2 and 6B, col 9, lines 23-35, col 17, lines 10-67, col 18, lines 1-5).

As per claims 22, 27 and 30-34, 36-40 Krishan substantially discloses, a method and apparatus for delivering targeted information and advertising over the Internet comprising:

monitoring the network data stream to detect data representative of the embedded code (see., abstract, figs 2 and 6B, col 9, lines 23-35, col 17, lines 10-67, col 18, lines 1-5);

recording a number of times the data representative of the embedded code is detected, the number of times the data representative of the embedded code is detected being indicative of presentation of the message to a user (see., abstract, figs 2 and 6B, col 9, lines 23-35, col 17, lines 10-67, col 18, lines 1-5); and

calculating a charge (or fee) for presenting the message based on the computer of times the data representative of the embedded code is detected (see., abstract, col 23, lines 5-30, specifically wherein said calculating a fee for displaying the one or more advertisements to the user).

It is to be noted that Krishan fails to explicitly disclose wherein said recording (or counting) the number of times the message is presented to a user of the communications network. However, Lee discloses a counter means associated with said monitoring means of said controller for counting the number of times each one of a plurality of said message identifiers is entered by the user indicating the number of

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times each message is requested to be played back to the user, and means for storing an accumulated count after each message is played back for permitting an operator to read out the accumulated counts (see., abstract, col 13, lines 25-33).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teaching of Krishan by including the limitation detailed above as taught by Williams because this would detect and count message data associate with each user (s).

As per claim 28, Krishan discloses the claimed method, wherein the communications network includes the internet (see., figs 1A and 1B, col 5, lines 52-67, col 6, lines 167, col 7, lines 1-67).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pierre E. Elisca whose telephone number is 703 305-3987. The examiner can normally be reached on 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703 305-9769. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Pierre Eddy Elisca

Primary Patent examiner

April 19, 2005